



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,804	06/30/2003	Nobuko Yamamoto	03500.015716.1	2559
5514 7590 02/22/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER BAUSCH, SARAE L	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 02/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/608,804

Applicant(s)

YAMAMOTO ET AL.

Examiner

Sarae Bausch

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 74-76.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see continuation.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

CONTINUATION

1. The amendment filed 02/09/2007 under 37 CFR 1.116 in reply to the final rejection has been entered. The final office action, mailed 10/31/2006, is maintained.
2. The amendment to claim 74 does not change the scope of the claims and the rejections of record are maintained.
3. With regard to the applicants arguments directed to the rejections under 35 U.S.C. 112(1), all arguments have been thoroughly reviewed but not found persuasive. The response asserts the specification at page 33, lines 30 through page 34, line 20 discuss the density of the matrix section and sets forth a relationship between density, spot width and section size and therefore the claimed range is supported by this discussed relationship coupled with specifically recited square sizes. The specification on page 33 lines 30 through page 34 line 20 discusses the density of the square and teaches square sizes of 500 μm , 1.2, and 6 mm but does not discuss side lengths of squares, much less a range of side lengths of squares nor a range of densities. Therefore, there is no support in the specification to use side lengths of 500 μm to 6 mm in length.

The response asserts that with respect to the absence of walls partitioning sections, example 5 discloses an array that is prepared by depositing probes on a glass substrate with a maleimide groups and inherently produces an array without partition walls. However, example 5 does not disclose an array that has a plurality of square sections with a side length of 500 μm to 6 mm and arranged in a matrix on solid substrate having no walls. Example 5 discloses a 2 mm square (no teachings of a plurality of squares) in which 64 DNAs were printed (see page 64, lines 12-16). Example 5 is silent with regard to the presence of walls on the substrate and does not

Art Unit: 1634

describe the partitions between the squares. However, the specification very clearly teaches a detection substrate with hydrophobic wall on the detection substrate, see page 29, lines 1-5 and page 41, lines 10-15 and therefore the lack of teaching of a walls on substrate in example 5 does not provide support for a plurality of square sections with a side length of 500 μm to 6 mm in length which are arranged in matrix form having no walls partitioning the sections.

4. With regard to the applicants arguments directed to the rejections under 35 U.S.C. 112(2), the amendment to the claims does not obviate the rejection of record. The response asserts that amended claim 74 further clarifies the feature of that the side length refers to the square sections. This response has been thoroughly reviewed but not found persuasive. The claims are still indefinite as it is still unclear if the limitation requires that each square has a length of 500 μm to 6 mm or if the plurality of square sections has at total side length of 500 μm to 6 mm.

5. With regard to the applicants arguments directed to the rejections of claims 74-76 under 35 U.S.C. 102(b) as anticipated by Southern or Brown et al., the response has been thoroughly reviewed but not found persuasive. The response asserts that neither Southern nor Brown teach a no walls partitioning the sections. The response asserts that Southern teaches the analyte is loaded for testing and that partitioning walls are necessary to be present to prevent contamination of adjacent sites. Southern et al. does not each partitioning walls and therefore anticipates the claimed invention and the response does not point specifically address where Southern et al. teach partitioning walls of adjacent sites.

The response asserts that Brown teaches forming a plurality of wells on a substrate,

Art Unit: 1634

however the response does not cite where Brown et al. teaches a plurality of wells that comprise walls on a substrate. Brown et al. teach an array with a plurality of analyte-specific reagents regions with diameter region and spacing and teach the support is treated to evaporate the liquid droplet from each region leaving an array of dried relatively flat regions (see column 9, lines 30-45). Brown et al. further teach grid patterns with grid lines (see column 12, lines 1-36) but does not teach the grid lines, grid patterns, or array are separated by a partitioning wall. Therefore, Brown et al. anticipated the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarae Bausch whose telephone number is (571) 272-2912. The examiner can normally be reached on M-F 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of


Art Unit: 1634

the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Sarah Bausch, PhD.
Examiner
Art Unit 1634



CARLA J. MYERS
PRIMARY EXAMINER